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**UNITED STATES PATENT AND TRADEMARK
OFFICE**
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mail date: June 13, 2005

Opposition No. 91125615

**University of Southern
California**

v.

University of South Carolina

**Before Hairston, Chapman and Kuhlke, Administrative Trademark
Judges.**

By the Board:

Applicant seeks to register the following mark:

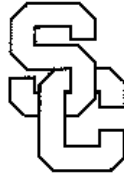


(hereinafter "SC stylized" mark) for "clothing, namely, hats, baseball uniforms, T-shirts and shorts."¹ As grounds for the opposition, set forth in its amended notice of opposition,² opposer alleges that applicant's mark so resembles opposer's previously used and registered marks, SC (standard character

¹ Application Serial No. 75358031, filed September 16, 1997.

² The amended notice of opposition, seeking to include ownership of a second registration, was accepted under Trademark Rule 2.107(a) by Board order dated August 16, 2004.

form) (hereinafter "SC" mark) for goods including "sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets"³ and



(herein after "SC interlock" mark) for goods including "clothing, namely, t-shirts, sweatshirts, polo shirts, warm-up suits, jackets, rain ponchos, sweaters, jerseys, tank tops, shorts, sport shirts, baseball shirts, basketball jerseys, golf sweaters, night shirts, boxer shorts, socks, hats, caps, sport caps, visor caps, beanies and ties,"⁴ as to be likely to cause confusion, mistake or to deceive. Opposer also alleges that applicant's mark dilutes the distinctive quality of opposer's marks.

In its answer to the amended notice of opposition, applicant denies the salient allegations of the amended notice of

³ Registration No. 1844953, issued on July 12, 1994, for goods in four international classes: "keyrings of non-precious metals; decorative emblems or plates of non-precious metal, for attachment to autos; art work statuary of non-precious metals, all goods being offered and sold to persons through university authorized channels of trade" in Class 6; "umbrellas, hand luggage, tote bags, luggage; namely, tote bags, hand luggage, garment bags for travel, and small traveling bags for overnight trips, fanny packs, toiletry bags sold empty, briefcases, back packs, all goods being offered and sold to persons through university authorized channels of trade" in Class 18; "towels, blankets, cloth pennants, and cloth flags, all goods being offered and sold to persons through university authorized channels of trade" in Class 24; and "sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets" in Class 25. Renewed.

⁴ Registration No. 2683137, issued on February 4, 2003, identifying goods and services in nine international classes (*i.e.*, Classes 12, 16, 18, 21, 24, 25, 28, 35, and 41).

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opposition, sets forth several affirmative defenses, and counterclaims to cancel opposer's pleaded Registration No. 2683137, for the SC interlock mark. As grounds for the counterclaim, applicant alleges priority of use of its letters "SC," which it also alleges is famous; and that, although it has denied in its answer that confusion is likely between opposer's pleaded SC and SC interlock marks and applicant's SC stylized mark, should confusion be found likely, applicant "possesses the superior common law rights to the SC mark." Applicant also alleges that it will be damaged, as the senior user, if opposer is permitted to retain its pleaded registration and oppose registration of applicant's mark under a theory of likelihood of confusion.

As background, in its original answer, applicant counterclaimed to cancel opposer's pleaded Registration No. 1844953 for the SC mark, alleging that the mark was registered through opposer's perpetration of fraud on the USPTO; that opposer's mark consists of "other insignia" of the state of South Carolina (Section 2(b) of the Trademark Act); and that opposer's mark falsely suggests a connection with South Carolina (Section 2(a) of the Trademark Act). In an order dated July 31, 2003, the Board, among other considerations, granted opposer's motion to dismiss (considered as one for summary judgment), and dismissed applicant's counterclaim in its entirety to cancel opposer's registration of the SC mark (Registration No. 1844953).

Subsequently, in an order dated April 29, 2004, the Board, finding the existence of genuine issues of material fact, denied opposer's motion for summary judgment, brought under its claim of priority and likelihood of confusion. At footnote 7 of the order, the Board informed the parties that, should opposer amend its pleading to plead its Registration No. 2683137 for the SC interlock mark, applicant may not raise the issue of priority with respect to such registered mark unless it files a proper counterclaim.

Opposer, on June 11, 2004, moved to amend its notice of opposition to plead Registration No. 2683137, and this was granted by the Board on August 16, 2004. After a series of consented motions to extend time, granted by the Board, applicant, on September 20, 2004, filed its answer to the amended notice of opposition, including a counterclaim to cancel Registration No. 2683137. In a Board order dated December 21, 2004, opposer was allowed time to file its answer to applicant's counterclaim.

This case now comes up on opposer's motion to dismiss applicant's counterclaim to cancel opposer's pleaded Registration No. 2683137 for the SC interlock mark. Such motion was filed in lieu of an answer to the counterclaim.

In support of its motion, opposer argues that, because the Board dismissed applicant's previous counterclaim to cancel opposer's registered SC mark (Registration No. 1844953) for goods

including clothing, under the *Morehouse* doctrine⁵ applicant cannot now challenge opposer's second registration (Registration No. 2683137), for the SC interlock mark for overlapping goods, which include clothing. More particularly, opposer argues that a stylized drawing and a typed drawing are equivalents, making opposer's SC mark and SC interlock mark the same mark; and that the goods identified in each registration are either identical or substantially the same, *i.e.*, "... goods commonly sold by universities as souvenirs and memorabilia so that alumnae and fans can express their support ..."

Opposer's motion is accompanied by TARR printouts of three of applicant's registrations for the mark UNIVERSITY OF SOUTH CAROLINA, offered to show that the goods identified in opposer's newer registration are "... within the same general class of University affiliated goods."⁶

In response, applicant argues that the Board, in its summary judgment order of April 29, 2004, found that genuine issues of material fact exist with respect to the following matters: 1) the scope of protection accorded opposer's marks based on its common law rights in its SC marks; 2) the similarities between the parties' respective SC marks in all forms, including the commercial impression of opposer's SC interlock mark and

⁵ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

⁶ Applicant's three registrations identify goods and services in Classes 6, 14, 16, 18, 21, 25, 26, and 41.

applicant's SC stylized mark; and 3) the priority of the parties' actual stylizations of their respective marks. Applicant argues that the Board provided further information regarding the necessity of a counterclaim should opposer amend the notice of opposition to include Registration No. 2683137, and that applicant acted in accordance with that information.

Applicant further argues that the *Morehouse* defense is an equitable defense not applicable here because opposer has not established as a matter of law that applicant knowingly delayed in challenging opposer's SC mark registration, particularly in view of applicant's denial in its original answer that its SC stylized mark is confusingly similar to opposer's SC mark; and that the *Morehouse* defense is not applicable because opposer's two pleaded registrations are not sufficiently identical. Specifically, applicant contends that the identified goods in opposer's SC mark registration are expressly limited in the channels of trade to "university authorized channels of trade" or to "university controlled outlets," while the identified goods and services in opposer's SC interlock registration are not so limited; that opposer's SC interlock mark includes an extensive listing of additional goods which are not substantially the same as the goods listed in the SC mark registration; and that the differences in opposer's "... prior and subsequent registration of the letters SC are significant." Finally, applicant argues that, while it suffered little to no damage from opposer's registration

of its SC mark, registration of opposer's SC interlock mark expands opposer's rights considerably, causing damage to applicant.

Applicant's response is accompanied by TARR printouts of opposer's two pleaded registrations.

In reply, opposer argues that the differences between its SC mark and its SC interlock mark are insubstantial because a typed drawing is equivalent to a stylized drawing for a *Morehouse* analysis; that the "university controlled channels of trade" argument made by applicant does not distinguish the parties' channels of trade or restrict opposer's channels of trade because stores that sell university logo products often sell products from many universities; and that the goods identified in its registrations are all easily recognizable and of the type commonly bought by college and university alumnae and fans.

As a preliminary matter, because opposer submitted with its motion to dismiss materials outside the pleadings, opposer's motion to dismiss is considered one for summary judgment. See Fed. R. Civ. P. 12(b)(6); and TBMP §503.04 (2d ed. rev. 2004).⁷

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of

⁷ Moreover, opposer's motion does not appear to be based on any of the grounds available in Fed. R. Civ. P. 12(b)(6) but, rather, on a theory of preclusion based on the *Morehouse* defense. Thus, consideration thereof is more appropriate in the context of a summary judgment motion.

law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

The prior registration or *Morehouse* defense is an equitable defense, to the effect that, if a plaintiff cannot be further injured because there already exists an injurious registration, the plaintiff cannot object to an additional registration that does not add to the injury. See *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); and *Morehouse Mfg. v. J. Strickland & Co.*, *supra*. The mark and the goods and/or services in the prior registration must be the same or substantially the same the mark and the goods and/or services in the application/registration at issue. See *Jacks-Evans Manufacturing Co. v. Jaybee Manufacturing Corp.*, 481 F.2d 1342, 179 USPQ 81 (CCPA 1973); and *Bausch & Lomb, Inc. v. Leupold & Steven, Inc.*, 1 USPQ2d 1497 (TTAB 1986).

Opposer relies on *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221 (TTAB 1987) for the proposition that, for the purposes of a *Morehouse* analysis, a standard character form of a

mark is legally equivalent to a stylized form. In that case, applicant sought to register the mark HELEN ARPELS for "perfume" and counterclaimed to cancel two of opposer's registrations, one of which was for the mark ADRIEN ARPEL, block form, for "cosmetics." Opposer asserted a *Morehouse* defense, with respect to this latter registration, based on a third, prior subsisting registration for the mark ADRIEN ARPEL, in stylized lettering, for a wide variety of cosmetics. The Board found opposer's pleaded marks to be substantially identical, stating in particular that, "... there can be no doubt that "ADRIEN ARPEL" whether represented in block form or stylized lettering is the single dominant commercial impression of both marks engendering the same and continuing commercial impression."⁸

S & L Acquisition does not set out a *per se* rule that a block or standard character mark is the legal equivalent of any potential stylized form of the mark. Furthermore, the situation presented in the case now before the Board is distinguishable on the facts because ADRIEN ARPEL connotes the name of an individual. Thus, there exists a genuine issue of material fact as to whether opposer's SC mark is substantially identical to opposer's SC interlock mark, in the context of the *Morehouse* defense.

⁸ In the *S & L Acquisition* case, the Board further found the cosmetic goods to be identical or substantially the same, and conditionally entered summary judgment on the counterclaim in opposer's favor (pending submission of a status and title copy of opposer's earliest registration).

In addition, a genuine issue of material fact exists as to whether the goods identified in opposer's SC mark registration are identical to or substantially the same as the goods and services identified in opposer's SC interlock registration. See, for example, *TBC Corp. v. Grand Prix*, 12 USPQ2d 1311 (TTAB 1989) ("...goods in the five registrations opposer relies upon for its prior registration defense are related to and within the natural scope of expansion of a producer of the goods listed in the three registrations applicant seeks to cancel. Nevertheless, the goods in the registrations are different. Therefore, opposer's ownership of the five other registrations cannot serve to preclude applicant from contesting opposer's right to maintain the three registrations applicant seeks to cancel."); *La Fara Importing Co. v. F. Lle de Cecco di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143 (TTAB 1988), (goods in the prior registration relied upon by applicant, "alimentary pastes," were found not to be identical to or substantially the same as the goods sought to be registered by applicant, which were "not only for alimentary pastes, but also includes a wide variety of additional items such as coffee, sugar, rice, cakes and sauces, excluding cranberry sauce and applesauce"); and *Missouri Silver Pages Directory Publishing Corp., Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028 (TTAB 1988), (goods in the prior existing registration asserted by applicant, "a telephone and discount directory addressed to senior citizens," were not found

to be substantially the same as the services sought to be registered, "compiling a telephone directory; promoting the goods and services of others through placing advertisements and listings in directories; and publication of telephone directories.").

In the present case, genuine issues of material fact exist as to whether the goods in opposer's earlier registration are identical to or substantially the same as the goods and services in its later registration (within the context of the *Morehouse* defense), including whether the goods and/or services in each registration travel in the same channels of trade.

Opposer has not shown that it is entitled to judgment as a matter of law. Accordingly, opposer's motion for summary judgment is denied.

Applicant's application Serial No. 75358031 published for opposition on May 18, 1999. Opposer, as potential opposer, obtained extensions of time to oppose totaling almost three years. Such extensions were largely with applicant's consent as the parties attempted to settle their dispute. Settlement is, of course, encouraged by the Board. This opposition was commenced on May 3, 2002. After three years, and the filing of numerous motions, the Board has just now considered another motion relating to the pleadings. The parties are reminded that the Board is an administrative tribunal with limited jurisdiction

over the question of registrability only. See Trademark Act §17; and TBMP §102.01 (2d ed. rev. 2004).

The Board has the inherent authority to control the disposition of the cases on its docket. See *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000). Consequently, in the interest of moving forward on this case, the Board will not entertain, and the parties are ordered not to file, any further motion(s) for summary judgment. Further delay of this case will be carefully scrutinized by the Board. If settlement is not possible, this case will go to trial on the following schedule:

THE PERIOD FOR DISCOVERY TO CLOSE: September 1, 2005

30-day testimony period for party
in position of plaintiff in the
opposition to close: November 30, 2005

30-day testimony period for party
in position of defendant in the
opposition and as plaintiff in
the counterclaim to close: January 29, 2006

30-day testimony period for party
in the position of defendant in the
counterclaim and its rebuttal as
plaintiff in the opposition to
close: March 30, 2006

15-day rebuttal testimony period
for plaintiff in the counterclaim
to close: May 14, 2006

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed as follows:

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Brief for plaintiff in the opposition
shall be due:

July 13, 2006

Brief for defendant in the opposition
and plaintiff in the counterclaim
shall be due:

August 12, 2006

Brief for defendant in the counterclaim
and its reply brief as
plaintiff in the opposition
shall be due:

September 11, 2006

Reply brief for plaintiff
in the counterclaim
shall be due:

September 26, 2006

An oral hearing will be set only upon request filed as
provided by Trademark Rule 2.129.

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